

**PATENT APPLICATION
042390.P5112**

REMARKS

Reexamination and reconsideration of this application is respectfully requested. Claims 1-11 remain in the application.

Applicant believes there is no charge for this response as no new claims have been added.

REQUEST FOR THE REMOVAL OF THE FINALITY OF THE OFFICE ACTION

Applicant objects to the Examiner's making the Office Action mailed on January 18, 2001 a final action. According to the Office Action, the new rejection based on Hasegawa was necessitated by Applicant's amendment. This is simply incorrect.

In Applicant's response mailed May 10, 1998, the only changes made to the claims was the removal of "the steps of" from the preamble of the claim. Applicant did not make any amendments to any limitations or features of the claims that was the basis of Examiner's previous rejection. The amendments simply broadened the claims to make clear that the claims do not invoke 35 USC § 112, second paragraph. The elements in the body of the claim were not amended as suggested by the Office Action.

Applicant's amendment did not necessitate the new ground for rejection. Instead, Applicant would like to respectfully point out that the new grounds of rejection relying upon Hasegawa was necessity due to the improper rejections made in the previous Office Action.

Accordingly, it is improper to make this Office Action final. Moreover, Applicant requests that the finality of this office action be removed so that Applicant may properly respond to the new rejection raised by the Examiner. If the Examiner declines to remove the finality of this office action, then Applicant hereby petitions to the Group Supervisor Examiner for reconsideration.

Allowed Claims

Applicant would also like to gratefully acknowledge the Examiner's indication that claims 2, 4, 7 and 9 would be allowable if the objection as being dependent upon a rejected base claim were overcome. Rather than incorporate the limitations of one of the allowable dependent claims into the independent claims, Applicant has

PATENT APPLICATION
042390.P5112

provided comments that demonstrate that all of the pending claims are allowable over the art of record.

Response to the 35 U.S.C. §103(a) Rejection

The Office Action rejects claims 1, 3, 5, 6, 8, and 10-11 under 35 U.S.C. §103(a) as being unpatentable over Crespo et al. (US 5,173,923) in view of Gudmundson (US 5,295,153). Applicant respectfully traverses this rejection in view of the remarks that follow.

To begin, the Office Action did not provide any explanation as to how or why the Office Action is relying on Gudmundson. Moreover, the Office Action did not provide any explanation as to why one skilled in the art would be motivated to combine the cited patents. Since no basis was provided, Applicant is left to speculate as to the basis of the rejection. Accordingly, the rejection is incomplete and the Office Action has not established a prima facie showing of obviousness. Applicant hereby requests that the rejection be withdrawn.

Response to the 35 U.S.C. §102(e) Rejection

The Office Action also rejects claims 1, 3, 5-6, 8, and 10-11 under 35 U.S.C. §102(e) as being anticipated by Gudmundson (US 5,295,153). Applicant respectfully traverses this rejection in view of the remarks that follow.

According to Office Action, "Gudmundson discloses a method comprising storing a plurality of PN code [sic]; assigning a set of PN codes to each transmitter; spreading the information signal using the PN codes and disspreading the information signal using the PN codes." In doing so, the Office Action relies on the abstract and col.6 lines 3-10 of Gudmundson.

However, Applicant would like to point out that the abstract of Gudmundson contains no teaching or even suggestion of PN codes. Instead, the abstract mentions allocating different sets of frequencies to cells. But, frequencies is a measure of the number of cycles of an radio frequency signals goes through per second. Frequencies have nothing to do with pseudo-noise codes (PN codes) of a signal. More importantly, the abstract of Gudmundson makes no mention of PN codes and Applicant respectfully submits that the reliance of the abstract as the basis for the rejection is improper.

The Office Action also relies on the teachings of Gudmundson at Column 6, lines 3-10 as a basis of the rejection. However, Applicant would like to point out

PATENT APPLICATION

042390.P5112

that the relied upon text of Gudmundson is devoid of any teaching or suggestion of codebooks as called for in Applicant's claim 1. As is well-established, in order to successfully assert a *prima facie* case of anticipation, the Examiner must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. If even one element or limitation is missing from the cited document, the Examiner has not succeeded in making a *prima facie* case.

Accordingly, Applicant respectfully submits that Gudmundson does not anticipate Applicant's claim 1 since it fails to teach or suggest, as one example, the use of codebooks. Since claims 2, 3, 5-6, 8 and 10-11 depend from independent claim 1, they are not anticipated by Gudmundson for at least the same reason.

Additional arguments to distinguish the cited patent from claim 1, as amended, could have been made, but it is believed that the foregoing discussion is sufficient to overcome the Examiner's rejection.

Response to the 35 U.S.C. §102(b) Rejection

The Office Action also rejects claims 1, 3, 8, and 10-11 under 35 U.S.C. §102(b) as being anticipated by Hasegawa (US 5,295,153). Similarly the Office Action also rejects claims 5-6 under 35 USC §103 as being obvious in view of Hasegawa. Since claims 5-6 are rejected in view of a single reference and because they depend from claim 1, Applicant will address these rejections together.

Applicant respectfully traverses this rejection in view of the remarks that follow.

Again, in order to successfully assert a *prima facie* case of anticipation, the Examiner must provide a single prior art document that includes every element and limitation of the claim or claims being rejected. In the Office Action, no explanation was provided as to how Hasegawa teaches or suggests the use of codebooks as called for in Applicant's claim 1. Thus, the Office Action has failed to establish a *prima facie* showing of anticipation. In addition, Applicant would like to point out that the portion of Hasegawa (figures 1-2 and related text) provide no teaching or even suggestion of the use of codebooks. Thus, the rejection of claim 1 in view of Hasegawa is improper and traversed. Since claims 3, 5-6, 8, and 10-11 depend from claim 1, they are not anticipated or obvious in view of Hasegawa for at least the same reason.

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PATENT APPLICATION

042390.P5112

Conclusion

The foregoing is submitted as a full and complete response to the Office Action mailed January 18, 2001, and it is submitted that claims 1-11 are in condition for allowance. Reconsideration of the rejection is requested.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or 1.17, (e.g. for petition fees for the removal of the finality of the office action) or any excess fee has been received, please charge that fee or credit the amount of overcharge to deposit account #02-2666.

If the Examiner believes that there are any informalities which can be corrected by an Examiner's amendment, a telephone call to the undersigned at (480) 554-9732 is respectfully solicited.

Respectfully submitted,

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